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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
LONSBERRY, HUNTER B	
ART UNIT	**PAPER NUMBER**
2611	

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/400,447	BASTIEN ET AL.	
	Examiner	Art Unit	
	Hunter B. Lonsberry	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 March 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21,23,24,27,29-37 and 39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-21, 23, 24, 27, 29-37 and 39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *8/19/02*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 17, 19, 23 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 3/7/05 have been fully considered but they are not persuasive.

1) Applicant argues that due to the large number of references used, impermissible hindsight mast have been used to make the combination (amendment pages 10-11).

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Applicant argues each of Erlin, Chaney and Hurta separately rather than in combination for the rejection to claim 1 (amendment pages 12-13).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that Hurta teaches away from the combination of Erlin, Chaney and Hurta, in that column 5, line 63-column 6, line 8 does not disclose having the capability to separately interact with both a user's smart card and users bank card (response page 13).

Regarding applicant's argument, the examiner Relies upon Erlin to teach interactions with a user's ATM card and Chaney for interactions with a user's smartcard. Hurta teaches that information on the smartcard may included credits which are debited from an account or charged to a credit account (column 5, line 63-column 6, line 8), thus Hurta does teach modifying information on a smart card in response to a payment as required by claim 1. Additionally, Hurta discloses that a the device which interacts with the smartcard may be an ATM, which enables a user to debit money from their banking account, or deposit cash directly (column 6, lines 9-14).

Applicant's failure to traverse the official notices in the previous office action is taken as admission of prior art.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1, 4, 5, 7-14, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,870,155 to Erlin in view of U.S. Patent 6,317,721 to Hurta and U.S. Patent 5,473,609 to Chaney.

Regarding claim 1, Erlin discloses in figure 4, a receiver/decoder 40 attached to a TV 42, a remote control 10 with a built in card reader (column 2, lines 38-61) for reading banking/credit information when the card is swiped through the card reader (column 1, lines 43-53, column 2, lines 38-61).

Erlin does not disclose the use of a user's smart card or modifying information on a smart card in response to a payment or modifying the information on the smart card remotely.

Chaney discloses a smart card within a user's receiver, a user may add or delete premium channels, the receiver is then tuned to a specified channel and receives a CA_CSS byte directed specifically to that smart card which changes the cards conditional access setup for differing services, a user may add or delete premium channels or purchase additional services which results in the data being changed (column 6, line 66- column 7, line 20), thus enabling the smart card data to be manipulated remotely and provide an easy way to add new services.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Erlin to utilize a remotely manipulated smart card as taught by

Chaney, thus enabling the smart card data to be manipulated remotely and provide an easy way to add new services.

The combination of Erlin and Chaney fails to disclose modifying the smart card data in response to a payment.

Hurta discloses a smart card 66 which is used to pay for tolls or other services, a user inserts the smart card into a machine similar to an ATM and inserts money or transfers funds from a credit account, this amount is then stored on the smart card and debited for each use of the smart card (column 5, line 63-column 6, line 40, column 8, line 46-column 9, line 33), thus enabling a user to pay for services at a number of different devices via the same smart card.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the cobinaiton of Erlin and Chaney to modify smart card data in response to a payment as taught by Hurta, thus enabling a user to pay for services at a number of different devices via the same smart card.

Regarding claim 4, Erlin discloses that the credit card information is read along with an amount to debit the credit account (column 5, lines 1-53).

Regarding claim 5, Erlin discloses that the receiver/decoder 40 may be used in conjunction with an ATM card to pay for goods or services. The system Erlin inherently receives authorization information from a remote center as the user's bank or other

financial institution must be contacted prior to funds being released to pay/credit for services/goods to be rendered, otherwise the service provider would not be paid.

Regarding claims 7-8, Hurta is relied upon to teach modifying credit information on a user's smart card in response to a payment, in particular Hurta discloses a smart card 66 which is used to pay for tolls or other services, a user inserts the smart card into a machine similar to an ATM and inserts money or transfers funds from a credit account, this amount is then stored on the smart card and debited for each use of the smart card (column 5, line 63-column 6, line 40, column 8, line 46-column 9, line 33).

Regarding claim 9, Erlin discloses a combination credit card/remote control, which is used to order good services or TV programming (column 5, lines 39-52).

The combination of Erling, Chaney and Hurta does not disclose including enouch gredit to purchase a plurality of products in each transaction.

The examiner takes official notice that the use of an ATM card to buy multiple products at the same time is well known in the art. Enabling a user to buy multiple products at once saves a user time

Therefore, it would have been obvious to one skilled in the art, at the time of invention to modify the combination of Erlin, Chaney and Hurta to enable a user to purchase a plurality of products at the same time thereby allowing a customer to make better use of their time.

Regarding claim 10, Erlin discloses that a user may enter their banking information in order to order casino cash, which may be picked up at the casino cashier (column 4, line 64-column 6, line 2).

Regarding claim 11, Erlin discloses that a user may purchase products from a home shopping network, interactive games or movies. Erlin inherently allows a user to input a request to purchase an item otherwise a user would not know how much money to debit their credit account.

Regarding claim 12, Erlin discloses in Figures 6D and E that a user may enter and confirm a PIN number (column 5, lines 18-27).

Regarding claim 13, Erlin discloses that the apparatus may be a remote control, which communicates with a set-top box (column 5, lines 53-59).

Regarding claim 14, Erlin discloses that the apparatus may be a remote control, which communicates with a set-top box (column 5, lines 53-59).

Erlin does not disclose a receiving satellite programs or fils.

The examiner takes official notice that the use of a set-top box which is connected to a digital sattelte system is notoriously well known in the art. Satellite systems allow a user to receive programs in remote locations.

Therefore, it would have been obvious to modify the combination of Erlin, Chaney and Hurta to utilize a set top box which reiceves programs from a sattlelite, thus allowing a user to receive programs in remote locations.

Regarding claim 20, Erlin discloses using a PIN number in Figures 6D and E.

Regarding claim 21, Erlin discloses that the remote control utilizes a DES encryption chip 65 (Figure 3, column 4, lines 18-20).

3. Claims 17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,870,155 to Erlin in view of U.S. Patent 5,351,296 to Sullivan.

Regarding claim 17, Erlin discloses in Figures 6A-H a method of ordering items and services in which a receiver/decoder 40 at a user site is used to select an item/service for purchase, read and sends bank/credit card information to a remote site for verification and transmitting the order for services/products such as a request for casino cash, and utilizes DES encryption to encrypt the IR signal between the remote control and the reciever (column 4, lines 17-20, line 64-column 6, line 2).

Erlin fails to disclose a verification step which includes inputting a random number by a user which is encrypted, decretping the random number at a remote center to verify the remote center.

Sullivan discloses combining a PIN number with random bits to create a 16 digit (64bit) number, this number is then DES encrypted (column 14, line 3-column 15, line 43) and decrypted at a remote center thus verifying the remote center and the user and providing an extra layer of security.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Elrin to utilize the random number and verification ability of Sulivan, thus providing an extra layer of security by verifying both the user and the remote center's identity.

Regarding claim 19, Erlin discloses in Figures 6A-H, a method of ordering items and services via a users ATM/credit card and checks if the credit card is valid (column 6, line 1-2).

4. Claims 2, 3, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,870,155 to Erlin in view of U.S. Patent 5,473,609 to Chaney and U.S. Patent 6,317,721 to Hurta in further view of U.S. Patent 5,491,827 to Holtey.

Regarding claims 2 and 3, Erlin discloses a remoter control with a card reader, which reads bank/credit cards (column 1, lines 43-53, column 2, lines 38-61).

The combination of Erlin Chaney and Hurta do not disclose interacting with a bank/ATM card that contains a microprocessor.

Holtey discloses in Figure 1, a card 3, with a microprocessor 10 and flash memory 103, which stores identification information such as a pin number (column 5, lines 10-25, column 6, lines 1-19), thus providing an extra security feature to protect the cards owner from having their credit card information stolen, and as a means for storing additional data on the credit card..

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the credit card from the combination of Erlin, Chaney, and Hurta to include the microprocessor and memory of Holtey in order to provide an extra security feature to protect the cards owner from having their credit card information stolen, and as a means for storing additional data on the credit card.

Regarding claim 15, Erlin discloses in figure 4, a receiver/decoder 40 attached to a TV 42, a remote control 10 with a built in card reader (column 2, lines 38-61) for reading banking/credit information when the card is swiped through the card reader (column 1, lines 43-53, column 2, lines 38-61).

Erlin does not disclose the use of a user's smart card which enables the ordering of products, modifying information on a smart card in response to a payment, modifying the information on the smart card remotely, and the use of a bank card with a microprocesor.

Chaney discloses a smart card within a user's receiver, a user may add or delete premium channels (products), the receiver is then tuned to a specified channel and receives a CA_CSS byte directed specifically to that smart card which changes the

cards conditional access setup for differing services, a user may add or delete premium channels or purchase additional services which results in the data being changed (column 6, line 66- column 7, line 20), thus enabling the smart card data to be manipulated remotely and provide an easy way to add new services.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Erlin to utilize a remotely manipulated smart card as taught by Chaney, thus enabling the smart card data to be manipulated remotely and provide an easy way to add new services.

The combination of Erlin and Chaney fails to disclose modifying the smart card data in response to a payment, and the use of a microprocessor within the user ATM or bank card.

Hurta discloses a smart card 66 which is used to pay for tolls or other services, a user inserts the smart card into a machine similar to an ATM and inserts money or transfers funds from a credit account, this amount is then stored on the smart card and debited for each use of the smart card (column 5, line 63-column 6, line 40, column 8, line 46-column 9, line 33), thus enabling a user to pay for services at a number of different devices via the same smart card.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Erlin and Chaney to modify smart card data in response to a payment as taught by Hurta, thus enabling a user to pay for services at a number of different devices via the same smart card.

The combination of Erlin, Chaney, and Hurta fails to disclose the use of a user's bank card which includes a microprocessor.

Holtey discloses in Figure 1, a card 3, with a microprocessor 10 and flash memory 103, which stores identification information such as a pin number (column 5, lines 10-25, column 6, lines 1-19), thus providing an extra security feature to protect the cards owner from having their credit card information stolen, and as a means for storing additional data on the credit card.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the credit card from the combination of Erlin, Chaney, and Hurta to include the microprocessor and memory of Holtey in order to provide an extra security feature to protect the cards owner from having their credit card information stolen, and as a means for storing additional data on the credit card.

Regarding claim 16, Erlin discloses that the receiver/decoder make be used at a hotel casino (column 1, lines 43-53).

The examiner takes official notice that digital satellite systems are known to have a wide subscriber base with each subscriber utilizing a receiver/decoder to access programming and shopping services.

Therefore, it would have been obvious to modify the combined system of Erlin/Chaney and Holtey in order to allow a plurality of end users to order programs and services.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,870,155 to Erlin in view of U.S. Patent 5,473,609 to Chaney and U.S. Patent 5,603,078 to Henderson.

Regarding claim 6, Erlin discloses a combination credit card/remote control that is used to order good services or TV programming (column 5, lines 39-52).

The combination of Erlin and Chaney does not disclose decoding or descrambling a video program in response to receiving authorization information.

Henderson discloses a combination remote/card reader 100 that reads a magnetic card and allows for video services to be purchased and displayed upon authorization from a control/billing computer (column 4, line 43-column 5, line 20), thus protecting the program providers revenue stream.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Erlin and Chaney to include the billing/control computer of Henderson in order to protect the program providers revenue stream.

6. Claims 23, 29-32, 33-35, 37 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,870,155 to Erlin in view of U.S. Patent 5473,609 to Chaney and U.S. Patent 5,602,581 to Ozaki.

Regading claim 23, Erlin discloses in figure 1 and 3 A remote controller with a bank card reader which is used with an item of equipment 40 (figure 4), comprising:

transmission means 59 for transmitting a user's Personal Identification Number to said item of equipment (column 5, lines 17-27), and

encryption means (column 4, lines 17-20) for encrypting the PIN nulmber, with a random number and passing the PIN number to the transmission means,

wherein the item of equipment 40 comprises a receiver for use in receiption of a television program (column 3, lines 27-33).

Erlin fails to disclose means at the receiver decoder for interacting with a user's credit or bank card to read credit or bank information, andfurther interacting means, separate from said interacting means for interacting with a user's smart card to read information from the smart card.

Chaney discloses a smart card within a user's receiver, a user may add or delete premium channels, the receiver is then tuned to a specified channel and receives a CA_CSS byte directed specifically to that smart card which changes the cards conditional access setup for differing services, a user may add or delete premium channels or purchase additional services which results in the data being changed (column 6, line 66- column 7, line 20), thus enabling the smart card data to be manipulated remotely and provide an easy way to add new services.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Erlin to utilize a remotely manipulated smart card as taught by Chaney, thus enabling the smart card data to be manipulated remotely and provide an easy way to add new services.

The combination of Erlin and Chaney fails to disclose means for reading and interacting with a users credit or bank card at the receiver.

Ozaki discloses a STB in figure 1, which includes a credit card reader 30 which reads the banking information stored on a magfnetic strip and allows a user to purchase programming, buttons 22 enable a user to provide inputs to the receiver without the need for a remote control (column 2, lines 13-44).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Erlin and Chaney to utilize the buttons on the receiver and credit card reader of Ozaki, thus enabling a user to easy order programming and allow the user to interact with the receiver if they can't find the remote control.

Regarding claim 24, Erlin discloses that the remote control utilizes an IR beam for transmitting data (column 2, lines 62-64).

Regarding claim 29, Erlin discloses utilizing a DES encryption chip 65 for encrypting the IR signal from the remote control (column 4, lines 17-20).

Regarding claims 30 and 31, Erlin discloses a combination credit card/remote control, which is used to order good services or TV programming via an ATM card (column 5, lines 39-52), DES encryption is applied to the PIN number to generate a random number.

The combination of Erlin, Chaney and Ozaki if the remote control is addressable or not or if this address is sent along with the random number and pin number.

The examiner takes official notice that the use of addresses in wireless devices is well known in order to designate information which is to be sent to a specific device is well known in the art.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify The combination of Erlin, Chaney and Ozaki to utilize an addressable remote control which sends the pin number, random number and address number in its communications in order to add an extra layer of security to financial transactions and guarantee that information is received at the proper devices.

Regarding claims 32, 33 and 37, Erlin discloses that a user transmits a PIN number, which is input via a remote control to a set top box (column 5, lines 18-59).

Regarding claim 34, Erlin discloses a remote control which utilizes DES encryption to generate a random number.

The combination of Erlin, Chaney and Ozaki fails to disclose the item of equipment generating a random number and displaying it on a display device.

The examiner takes official notice that the use of a random number session ID displayed by a reciever is notoriously well known in the art. Random numbers provide an extra layer of security between a transmitter and receiver pair.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Erlin, Chaney and Ozaki to utilize a random number displayed by the receiver thus providing an additional layer of security between the transmitter/receiver pair.

Regarding claim 35, Erlin discloses a remote control which utilizes DES encryption to generate a random number.

The combination of Erlin, Chaney and Ozaki fails to disclose the item of equipment generatinga random number and transmitting it to the remote control.

The examiner takes official notice that the use of a random number session ID generated by a receiver is notoriously well known in the art, for example a rolling code garage door opening system. Random numbers provide an extra layer of security between a transmitter and receiver pair.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Erlin, Chaney and Ozaki to utilize a random number generated by the receiver thus providing an additional layer of security between the transmitter/receiver pair.

Regarding claim 39, Erlin discloses that a user transmits a PIN number, which is input via a remote control to a set top box (column 5, lines 18-59) and that the remote control utilizes an IR beam for transmitting data (column 2, lines 62-64), the PIN is displayed on a TV (Figure 6e).

7. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,870,155 to Erlin in view of U.S. Patent 5473,609 to Chaney and U.S. Patent 5,602,581 to Ozaki in further view of U.S. Patent 5,787,154 to Hazra.

Regarding claim 27, Erlin discloses a receiver for used in the receiption of television programs, a combination credit card/remote control is used to order good services or TV programming via an ATM card (column 5, lines 39-52).

The combination of Erlin, Chaney and Ozaki does not disclose, enabling the user to input a random number.

Hazra discloses a smart card like authentication device in figure 5, in which a user may utilize a keypad to enter a PIN or a random number, the device then communicates with a telephone to authenticate the user (column 2, line 31-column 3, line 49), thus providing an extra layer of security.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Erlin, Chaney and Ozaki to enabling a user to input the random number as an additional layer of security as taught by Hazra.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-

272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HBL

CHRIS GRANT
PRIMARY EXAMINER